

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

UV-3 Cont. 5

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on _____

Signature _____

Typed or printed name _____

Application Number

10/759,371

Filed

January 15, 2004

First Named Inventor

Connie T. Marshall

Art Unit

2423

Examiner

Ricky Chin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Matthew S. Bertenthal/

Signature

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

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February 5, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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CONCISE ARGUMENT FOR WHICH REVIEW IS BEING REQUESTED

I. Introduction

Claims 1-12 are pending in this application. Claims 1, 2, 4, and 12 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Banker et al. U.S. Patent No. 5,579,057 (hereinafter "Banker"). Claims 3, 5, 6, and 11 have been rejected under 35 U.S.C. § 103(a) as being obvious over Banker. Claims 7-9 are rejected under 35 U.S.C. § 103(a) as being obvious over Banker in view of Young et al. U.S. Patent No. 5,479,268. Applicants respectfully traverse the rejections. Claim 10 is rejected under 35 U.S.C. § 103(a) as being obvious over Banker in view of Hamilton et al. U.S. Patent No. 5,579,055.

II. Summary of Arguments

For the purposes of this Request, applicants will specify the clear error in the rejection of independent claims 1, 11, and 12. Namely, applicants will demonstrate that Banker does not show or suggest each and every element of applicants' claimed invention and that applicants' claims are not obvious over Banker. Applicants reserve the right to present additional arguments subsequent to the decision of the panel review.

III. Summary of Telephonic Interview

Applicants would like to thank the Examiner for the courtesies extended during the January 27, 2009 telephonic interview with the undersigned. During the interview, applicants discussed the invention and Banker, and no agreement was reached.

IV. The Rejection of Independent Claims 1 and 12

The Examiner rejected claims 1 and 12 as under 35 U.S.C. § 102(e) as being anticipated by Banker. The rejection is respectfully traversed.

Applicants' independent claims 1 and 12 are, *inter alia*, directed toward computer readable storage media that includes instructions for superimposing an interactive program guide with a perceived partial transparency over a television program such that the television program can be at least partially perceived by a television viewer through the interactive program guide.

Banker discloses the display of symbols which are defined as a fixed array of pixels which are stored in display memory (Banker, col. 3, lines 23-26). Each pixel in each symbol can be one of four colors – either black, white, a background color, or a foreground color (Banker, col. 3, lines 36-38). Banker then describes its "transparent" effect through the following:

Normally, the symbols have a foreground color for the symbol pixels of the array and a background color for the background pixels of the array. The symbol array pixels are then substituted for the pixels of the active video and the foreground colors and background colors fill the screen, i.e., white letters on a blue background. However, the active video background feature inverts the choice of the symbol array pixel versus the active video pixel making the background pixels of the symbols appear transparent. Banker, col. 4, lines 2-11 (emphasis added).

As shown above, Banker replaces the background pixels of a symbol with pixels of active video which results in an opaque character superimposed on the active video. In particular, the background of the symbols appear transparent (i.e., passing light completely) while the symbols themselves are opaque (i.e., impenetrable to light). This display is clearly different from a perceived partial transparency (e.g., allowing only some light to pass) allowing a television program to be partially perceived by a television viewer through an interactive program guide, as required by applicants' claims.

On page 2 of the Office Action, the Examiner maintains that Banker shows applicants' claimed "perceived partial transparency" in "disclos[ing] that the background pixels of the symbols can be made transparent and that each pixel of a graphics screen has a defined color which can be selected to be a transparent color making use for easy overlay on the active video to show cutout portions and other special effects." However, contrary to the Examiner's assertions, "making the background pixels of the symbols ... transparent" does not create a perceived partial transparency, as required by applicants' claims. In particular, applicants' claims specify that in the perceived partial transparency, a television program can be partially perceived by a television viewer through an interactive program guide. The background of Banker's symbol pixels is either a symbol pixel or an active video pixel. Thus, Banker does not show or suggest a "perceived partial transparency" that allows viewing of a television program through a guide (e.g., in the same screen region).

The Examiner further argues that "col. 3, lines 36-67 and col. 24, line 54-col. 25 line 40 discloses selecting the pixel color of each symbol which can be one of the background or foreground color, thereby making the symbol transparent if need be." Applicants respectfully submit that nowhere do these portions of Banker show or suggest "making the symbol transparent if need be." Instead, these portions of Banker describe how pixel data is decoded and displayed. A foreground mode bit, if set, causes the luminance value in a symbol's palette to be inverted, which causes the intensity of colored symbols to be reversed such that bright characters will become dim and vice versa but not transparent, let alone partially transparent, as required by applicants' claims. A blink bit, if set, inverts the choice of the foreground color and background color during a configurable portion of the blink cycle. Finally, an underline bit, if set, causes the last line of pixels to be output as an underline color. Nowhere do these portions of Banker show or suggest "making the symbol transparent," as claimed by the Examiner.

Assuming that Banker can select the symbol display to be all background color as the Examiner suggests, this would still not show a perceived partial transparency in which a television program could be at least partially perceived by a television viewer through an interactive program guide. Instead, a viewer would only see a display of active video pixels without any symbols. This display would not include anything resembling an interactive program guide, let alone a partial transparency between a television program and an interactive program guide, as required by applicants' claims.

Finally, the Examiner argues that "even if the character was fixed to be opaque, the background which the character is displayed on is made transparent and therefore there is 'perceived partial transparency' where the active video can be at least partially perceived as claimed, since any part of an overlaid graphic which is transparent including the background pixels of the symbol would yield to the active video being partially perceived." Applicants respectfully disagree.

Applicants respectfully submit that the Examiner is not giving each and every limitation of claims 1 and 12 their full patentable weight. As set forth in *Verdegaal Bros. v. Union Oil Co. of California*, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," 814 F.2d 628, 631 (Fed. Cir. 1987). In particular, applicants respectfully submit that the Examiner is not taking into account applicants' claim element that requires the "perceived partial

transparency" to be "over a television program such that the television program can be at least partially perceived by a television viewer through [an] interactive program guide" (emphasis added). As argued above, nowhere does Banker expressly or inherently describe that its active video pixels can be at least partially perceived through its symbol pixels – Banker merely replaces (i.e. removes from display) the background pixels of a symbol with pixels of active video. Thus, contrary to the Examiner's claim, the active video is not "partially perceived," as required by applicants' claims. If the active video pixels replace the background pixels of a symbol, the viewer simply sees the active video pixels juxtaposed with the opaque symbol pixels. Nowhere does the viewer see the active video through the symbols themselves (e.g., pixel parts of both the symbols and the video in the same portion of the screen). Accordingly, Banker does not show or suggest the "perceived partial transparency" of applicants' claims.

Additionally, Banker does not apply a perceived partial transparency to an "interactive program guide" as required by applicants' claims. Applicants respectfully submit that nowhere does Banker show or suggest that its symbols are interactive when applying its "transparent" effect. Instead, Banker describes its symbols as fixed array of pixels which are stored in display memory. Banker then replaces the background pixels of these symbols with pixels of active video which results in an opaque character superimposed on the active video. Nowhere does Banker show or suggest interactivity with its symbols during this process. Accordingly, Banker does not show or suggest a perceived partial transparency in an "interactive program guide," as required by applicants' claims.

For at least these reasons, Banker does not show all the features of applicants' independent claims 1 and 12. Applicants respectfully request, therefore, that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn.

V. The Rejection of Independent Claim 11

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being obvious over Banker. The rejection is respectfully traversed.

Applicants' claim 11 is directed toward, *inter alia*, computer readable storage media that includes instructions for superimposing an interactive program guide with a perceived partial transparency over a television program. The instructions allow variability of a weight of the transparency relative to a display image.

As described above in Section III, Banker discusses the display of opaque character superimposed on active video by "making the background pixels of the symbols appear transparent." A particular color or group of colors may be assigned to be a "transparent color" code in memory (Banker, col. 23, lines 29-46). When that color is sensed, the display system, instead of attempting to convert that pixel into a color, selects the active video pixel for display. (Banker, col. 4, lines 12-20).

Applicants' respectfully submit that nowhere does Banker show or suggest varying the weight of a perceived partial transparency between an interactive program guide and a television program. Instead, Banker shows a mechanism for marking pixels in memory with a "transparent color", and then displaying an active video pixel when that color is detected. This substitution of active video pixels for "transparent color" pixels in no way resembles varying the weight of a perceived partial transparency between an interactive program guide and a television program. Further, nowhere does Banker show or suggest varying the weight of a transparency between any of its symbol pixels and active video pixels – Banker's active video pixels are merely juxtaposed with opaque symbol pixels. For at least these reasons, applicants submit that independent claim 11 is patentable over Banker, and that the Examiner's rejection under 35 U.S.C. § 103(a) should be withdrawn.

VI. Conclusion

Claims 2-10 depend on independent claim 1, and are allowable at least because claim allowable. For at least the foregoing reasons, applicants submit that this application is in condition for allowance. Reconsideration and allowance are respectfully requested.

Respectfully submitted,

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